

### **REMARKS/ARGUMENTS**

Claims 1-23 are pending in the application and stand rejected. The final action of February 28, 2003 continued the obviousness rejections from the office action of August 12, 2002. Each of the rejections is based, at least in part, on the combination of U.S. Pat. No. 5,763,028 to Matsumoto *et al.* and U.S. Pat. No. 6,407,155 to Qian *et al.*

A Declaration of Francis J. Bensur under 37 CFR 132 is attached hereto. A Request for Continued Examination (RCE) is being filed concurrently herewith to reopen prosecution and provide for entry of Mr. Bensur's declaration.

The Examiner has acknowledged that the references relied upon to reject claims 1-23 do not disclose an adhesive including clay platelets for bonding film layers of a packaging laminate in the manner required. The Examiner, however, has taken the position that it would have been obvious to modify the laminates disclosed in the references relied upon to include clay platelets in a laminating adhesive instead of within a film layer as taught by the references.

In reply to Applicant's arguments submitted in response of the office action of August 12, 2002, incorporated herein by this reference thereto, the Examiner asserted in the final action that modification of the references to include clay in the bonding adhesive instead of one of the film layers is suggested because the bonding adhesive "becomes a clay-containing intermediate layer in the finished laminate."

The Declaration of Francis J. Bensur evidences that those skilled in the art of flexible packaging distinguish laminating adhesives from film layers of a laminate that are bonded together by such adhesives. Those skilled in the art of flexible packaging distinguish film layers and laminating adhesives based on differences in manufacture/application (*i.e.*, extruded films versus adhesives laminated in a liquid phase). Those skilled in the art also distinguish film layers and laminating adhesives based on the manner in which their inclusion in a packaging laminate is specified (*i.e.*, thickness for the film layers and unit weights instead of thickness for the relatively thin applications of adhesive required in a packaging laminate). Those skilled in the art further distinguish film layers and laminating adhesives based on required

chemistry (*i.e.*, "two-part type" adhesive formulations laminated in liquid phase and special requirements regarding moisture content and dispersion for an additive such as clay).

The Declaration of Francis J. Bensur evidences that, contrary to the position taken by the Examiner, the teaching in the cited references of clay platelets within a film layer would not have suggested to one skilled in the art inclusion of clay platelets within a laminating adhesive.

It is well established that a *prima facie* case of obviousness cannot be established through hindsight use of the applicant's disclosure. See, *e.g.*, In re Fritch, 23 USPQ2d 1780 (Fed. Cir., 1992); and In re Dance, 48 USPQ2d 1635 (Fed. Cir., 1998). "[I]t is the prior art itself, and *not the applicant's achievement*, that must establish [obviousness]." In re Dance, 48 USPQ2d at 1637 (Emphasis added). In the present case, the improper hindsight use of applicant's invention, in the manner of a shopping list, is evidenced in the assertion that "in *terms of ingredients*, the Matsumoto patent lacks only the clay additive, which Qian uses." Page 5 of final action (Emphasis added, citation omitted).

For the foregoing reasons, the obviousness rejections of claims 1-23 are improper and should be withdrawn.

The final action also included a new rejection of claim 9 under Section 112, first paragraph. The Examiner quoted a portion of the claim, namely that "the bonding of adjacent layers within the laminate portions is not effected by the welding of the polypropylene", and asserted that the quoted portion was *not recited* in the original application. This rejection improperly requires verbatim support for the language of claim 9, which had been amended in response to the office action of August 12, 2002.

The original application describes that prior art packaging included sheets of laminated material sealed together by heat-sealing (See, *e.g.*, page 1, lines 20-23). The application describes that a prior art laminated material included layers of PET, metal foil, polyamide and polypropylene bonded together using a urethane adhesive. (See, *e.g.*, page 2, lines 25-29). The application further describes that the polypropylene layer provides a:

heat-sealable inner surface that can be *welded* to itself to form an airtight package, with a softening temperature low enough to be sealed *without damaging* the contents, or *the laminate structure*, but high enough to survive the retorting of the sealed package. (Page 3, lines 19-23)(Emphasis added).

Original claim 9 of the application as filed depended from claim 1 and required that "bonding is effected by welding of the polypropylene." In reviewing original claim 9 in light of the stated goal appearing on page 2 of the specification for welding of laminate portions without damage to the laminate structure, it was determined that an error had occurred. Claim 9 was amended to depend from original claim 8, which requires a pouch having a seam in which the polypropylene layers of two laminate portions lie face to face at their edges. A pouch comprising portions of a packaging laminate joined together at its edges is shown in Figures 1 and 2 of the drawings and described on pages 5-6 of the specification. Claim 9 was further amended to require welding of the laminate portions of the pouch of claim 8 to join the laminate portions, and to require that the bonding between layers of the two laminate portions is not effected by the welding.

There is no requirement that claim language be *recited* verbatim elsewhere in the specification. To the contrary, adequate written description may be found where the only written support for the claim language appears in the claims themselves (See, e.g., MPEP Section 2163, Subpart I). In fact, written support for claim language is presumed, placing the burden on the Examiner to evidence why persons skilled in the art would not recognize in the disclosure a sufficient description of the claimed invention (See, e.g., MPEP Section 2163, Subpart I.A). With respect to amended claim language, written support may be through express, implicit, or inherent disclosure. Furthermore, an amendment to correct an error is supported when one skilled in the art would recognize the error and the appropriate correction.

For the above reasons, the rejection of claim 9 under Section 112, first paragraph is improper and should be withdrawn.

It is respectfully submitted that the application is now in condition for allowance. If the Examiner believes that direct communication would advance the prosecution, the Examiner is invited to telephone the undersigned.

Respectfully submitted,  
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